



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
Iain Smyth

Serial No. 10/523,757

Docket No. 1570.3043.001

Filed: February 8, 2005

For: A CASE

CERTIFICATE OF EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail No. EV 463063440 US in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on *Sept. 12, 2007*.


Suzanne J. Wills

RESPONSE UNDER RULE §312

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

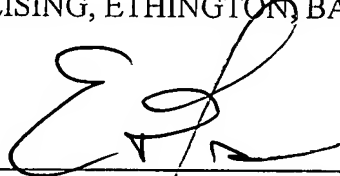
Pursuant to the Examiner's request, the applicant submits this Response under §312 to contend that the Declaration as originally submitted is not defective as stated in the Office Action dated June 18, 2007. Please see OG Notices 1135 O.G. 13-25 Comment 38 and its Reply, as well as 1138 O.G. 37-41, which states that "Declaration forms acceptable under the rules in effect prior to the change effective March 16, 1992 will continue to be acceptable under the new rules". The applicant believes that this procedure is still in effect and has never been controverted or overruled.

For your convenience, the applicant has attached copies of both notices as Exhibits A and B. As such, the applicant requests that the objection to the Declaration mailed with the Office Action dated June 18, 2007 be withdrawn.

If it is determined that any fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fees to our Deposit Account No. 59-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.



Eric T. Jones, Reg. No. 40,037
P.O. Box 4390
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(248) 689-3500

Date: 12 Sep 07

1135 O.G. 13-25

January 9, 1992

Patent and Trademark Office 37 CFR Parts 1 and 10

[Docket No. 910764-1306]

RIN: 0651-AA27

Duty of Disclosure

Agency: Patent and Trademark Office, Commerce

Action: Notice of final rulemaking.

Summary: The Patent and Trademark Office (Office) is amending the rules of practice in patent cases to (1) clarify the duty of disclosure for information required to be submitted to the Office; (2) provide flexible time limits for submitting information disclosure statements including the requirement for a fee in certain cases; (3) eliminate consideration of duty of disclosure issues by the Office except in disciplinary and interference proceedings, and under other limited circumstances; and (4) eliminate the striking of patent applications which are improperly executed. The Office further is amending the Patent and Trademark Office Code of Professional Responsibility to define as misconduct a failure to comply with the rules on duty of disclosure. The rules as adopted strike a balance between the need of the Office to obtain and consider all known relevant information pertaining to patentability before a patent is granted and the desire to avoid or minimize unnecessary complications in the enforcement of patents.

Effective Date: March 16, 1992. These rules will be applicable to all applicants and reexamination proceedings pending or filed after the effective date.

For Further Information Contact: By telephone Charles E. Van Horn (703-305-9054) or J. Michael Thesz (703-305-9384) or by mail addressed to Commissioner of Patents and Trademarks, Washington, DC 20231, and marked to the attention of Charles E. Van Horn (Crystal Park 2—room 919).

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Reply: No modification to § 1.56(c)(3) is needed since § 1.56 sets forth that only individuals who are associated with the filing and prosecution of a patent application have a duty of candor and good faith, including a duty to disclose to the Office all information known to be material to patentability.

Comment 36. One comment stated that proposed § 1.56(d) should be revised to expressly allow an inventor to satisfy the duty by disclosing information to the practitioner who prepares or prosecutes the application so that redundant information disclosure statements will not be required from both the inventor and the attorney or agent.

Reply: The suggestion in the comment is not adopted since the duty as described in § 1.56 will be met as long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98 before issuance of the patent. Statements from both an inventor and the practitioner are not required to be submitted.

Comment 37. One comment stated that proposed §§ 1.52(e) and 1.67(e) should be modified to either (1) expressly permit alterations to be made in an application subsequent to the signing of the oath or declaration if a supplemental oath or declaration is later submitted, or (2) more properly, prohibit such alterations since if alterations are desirable, they can be made and the application can be filed with an unsigned oath or declaration. Another comment stated that willfully filling out false oaths should never be condoned.

Reply: The Office does not condone willfully filling out false oaths. Further, § 10.28(c)(11) indicates that the Office considers it misconduct for a practitioner to knowingly file or cause to be filed an application containing a material alteration made after the signing of an accompanying oath or declaration without identifying the alteration. The Office will not consider striking an application in which an alteration was made, but a supplemental oath or declaration is required to be filed in an application containing alterations made after the signing of the oath or declaration.

Comment 38. One comment stated that the implementation of proposed §§ 1.63(b)(3) and 1.175(a)(7) allows for a two-month delay in the deadline for requiring declarations complying therewith.

Reply: The averments in oath or declaration forms presently in use that comply with the previous § 1.63 or § 1.175 will also comply with the requirements of the new rules. Therefore, the Office will continue to accept the old oath or declaration forms as complying with the new rules.

Comment 39. Five comments questioned the need for the proposed rules since statistics show that information disclosure statements are

1138 O.G. 37-41

April 20, 1992

**Implementation of Rules on Information
Disclosure Statements**

New rules on the duty of disclosure and information disclosure statements, effective March 16, 1992, were published in the *Federal Register* at 57 FR 2021 (Jan. 17, 1992) and in the *Official Gazette* at 1135 Off. Gaz. Pat. Office 13 (Feb. 4, 1992).

The procedures for handling information disclosure statements (37 CFR 1.97 and 1.98) will be set forth in Section 609 of the Manual of Patent Examining Procedure (MPEP). A copy of the instructions being given to examiners for handling information disclosure statements under the new rules is being published for the benefit of the public. Also being published is a sample declaration form which incorporates language conforming to the amendment to 37 CFR 1.63 contained in the new rules. Declaration forms acceptable under the rules in effect prior to the change effective March 16, 1992, will continue to be acceptable under the new rules.

The Office is considering changing its policy regarding the printing on patents of citations of information considered in patent applications. The proposed change will not affect consideration by the examiner of information submitted to the Office in compliance with 37 CFR 1.97(b)-(d) and 1.98. The proposed change affects only the information printed on the patent. Presently, as set forth in the last paragraph of the instructions which follow, information properly submitted by applicant and considered by the examiner will be printed on the patent along with the references cited by the examiner in Office actions. It has been suggested that it would be more helpful to the Office and to the public in using a patent for future search purposes if only the references cited and/or relied upon by the examiner in Office actions were listed on the printed patent. Alternatively, it has been suggested that the references listed on a patent be differentiated as to whether they were cited and/or relied on by the examiner or cited by applicant but not relied on by the examiner. The Office has a preference for the option that lists only the information cited and/or relied on by the examiner because it reduces printing costs (some citations by applicants now add several additional pages to the patent grant) and minimizes processing problems associated with correcting incomplete or inaccurate citations before the patent is printed. Public comment on these proposals is welcomed and should be directed to J. Michael Thesz (703-305-9384) or by mail directed to Mr. Thesz in the Office of the Assistant Commissioner for Patents. Comments should be received before May 29, 1992.

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April 20, 1992

HARRY F. MANBECK, Jr.

*Assistant Secretary and Commissioner
of Patents and Trademarks*

**Processing of Information Disclosure Statements
Under the New Rules Effective March 16, 1992**

Applicants and other individuals substantively involved with the preparation and/or prosecution of a patent application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. These individuals also may want the Office to consider information for a variety of other reasons, e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantively involved with the preparation or prosecution of a patent application.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 1.98 provides the procedure available to an applicant to submit information to the Office so that information will be considered by the examiner assigned to the application. The requirements for the content of a statement have been simplified in the new rules effective March 16, 1992, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the office so the examiner can determine its relevance to the claimed invention. The procedure for submitting an information disclosure statement under the new rules are designed to encourage individuals to submit information to the Office promptly.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with 37 CFR 1.98 as to content must be filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in A below. The requirements based on the time of filing the statement are discussed in B below. Examiner handling of information disclosure statement is discussed in C below.

The Office has set forth the minimum requirements for information to be considered in 37 CFR 1.97 and 1.98. Once the minimum

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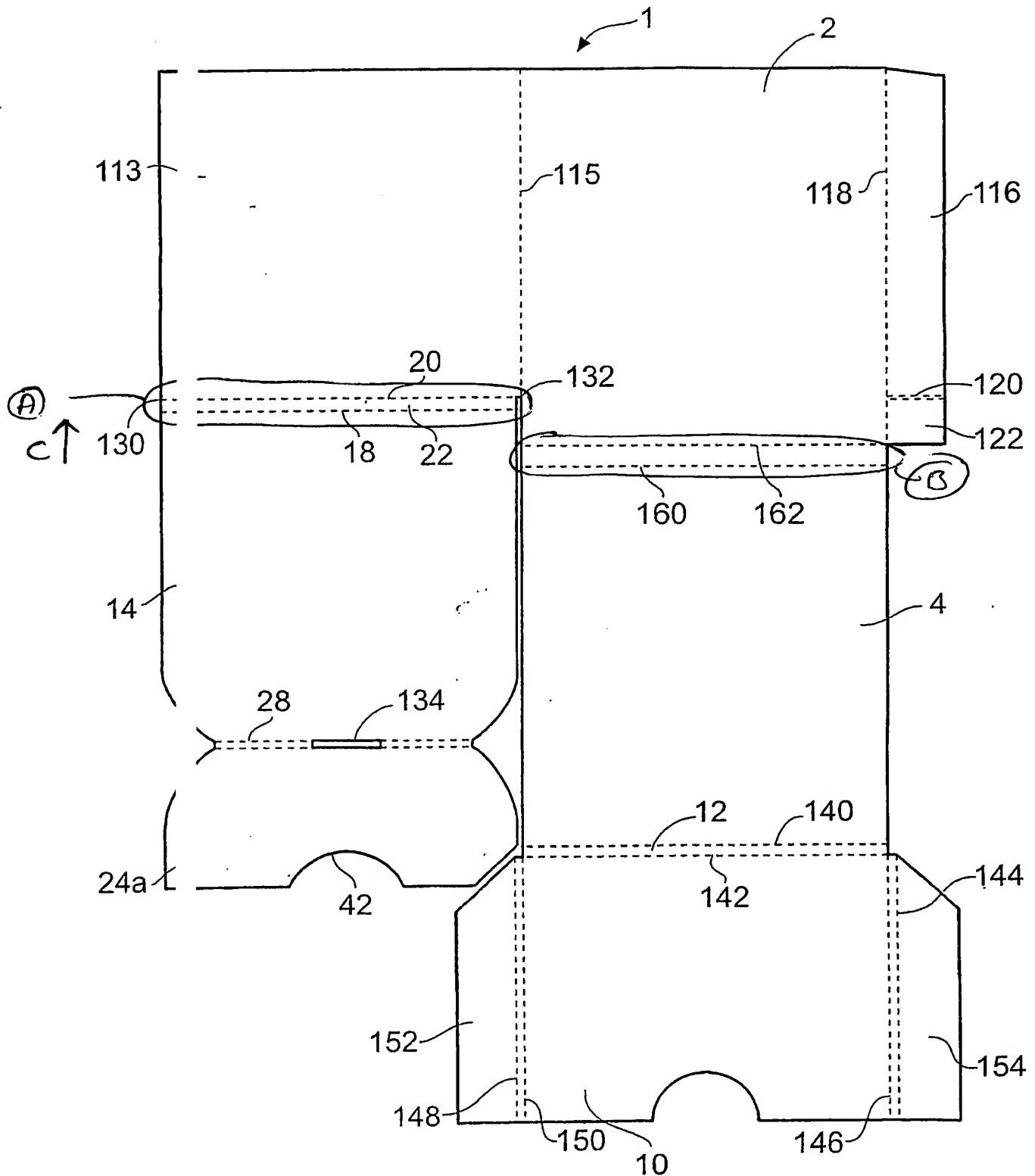


Fig. 9